

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of April 21, 2006. Reconsideration of the Application is requested.

The Office Action

Claims 1-34 remain in this application.

Claims 1-6, 15-19, 21-24, 33 and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Allen, et al. (U.S. Patent No. 6,549,299).

Claims 7, 8, 14, 20, 25, 26, and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Allen, in view of Hower, Jr. et al. (U.S. Patent No. 5,467,434).

Claims 9-13, and 27-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Allen in view of Hower, and further in view of Neilsen (U.S. Patent No. 6,639,687).

A. Rejection of Claims 1-6, 15-19, 21-24, 33 and 34 Under 35 U.S.C. §102(e)

Claims 1-6, 15-19, 21-24, 33 and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Allen, et al. (U.S. Patent No. 6,549,299). It is respectfully requested that this rejection be withdrawn for at least the following reason. Allen, et al. does not teach or suggest each and every element of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes ***each and every limitation set forth in the patent claim.*** *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the...claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 (and similarly independent claim 21) recites a production and finishing system for producing and finishing work pieces of a job. A production device produces the work pieces of the job and a finishing device finishes the output of the production device, such finishing device being controlled separately from the production device and having at least one constraint. A production monitor controller outputs job coordination information, which ***coordination information is based at least in part upon***

constraints of the finishing device. A finishing module coordinator that, after receiving job coordination information output from the production monitor controller, directs operation of the finishing device. Allen does not teach or suggest such claimed elements of the subject application.

In particular, Allen does not teach or suggest a production monitor controller that outputs **job coordination information which is based at least upon constraints of a finishing device**, as recited in the subject claims. Instead, Allen employs an instruction sheet that is generated via a disparate computer to instruct a standalone finishing machine how to operate. (col.2, lines 51-53). There is no mention of considering the constraints of the finishing machine. There is no mention of the computer having access to, or being able to formulate instructions that relate to the constraints of the finishing machine. Thus, consideration of constraints is not contemplated by Allen.

In the Office Action dated April 21, 2006, the examiner contends that Allen "discloses finishing options that are based on limitations of the finishing machine (col. 3, lines 17-26). For example, a document will not include an option to be stapled if the finishing machine is not capable of stapling." See Page 2, paragraph 1. However, col. 3, lines 17-26 of Allen merely discloses printing a computer-readable instruction sheet containing computer readable finishing instructions. There is no mention of **generating such instructions based at least in part upon constraints of a finishing device**. Allen does not contemplate, teach or suggest job coordination information which is based at least in part upon constraints of a finishing device.

Further, Allen does not teach or suggest the stapling example presented by the examiner. There is no mention of a document that includes **instructions based at least in part upon constraints of the finishing device**. For instance, as disclosed by Allen, the instructions simply relate to one or more tasks to be performed by a finishing machine. However, **there is no mechanism, device or process disclosed by Allen that outputs these instructions based on the constraints of the finishing device**. Such intelligent instruction generation is recited in the subject claims and is manifestly absent from Allen.

As disclosed in the specification of the subject application, a constraint relates to "innumerable equipment and processing parameters that characterize and constrain use of each piece of equipment." See e.g., page 11, para. 2. For example, equipment can have different paper path constraints, bin height constraints, sheet stock properties, finishing

requirements, orientation, etc. *Id.* Allen does not teach or suggest constraints related to the finishing device, as recited in the subject claims. Rather, Allen only considers input from an operator to enter instructions in a computer to generate an instruction sheet. See Abstract (col. 2, lines 51-53). ***Allen does not mention or consider any constraints related to the stand alone finishing machine*** when the instruction sheet is prepared by the computer. Allen does not teach or suggest the identification of constraints nor the direction of the finishing machine based at least in part upon such constraints, as recited in the subject claims. Accordingly, ***nowhere does Allen fairly suggest conforming a finishing job to constraints.***

For at least the aforementioned reasons, it is respectfully submitted that Allen does not teach or suggest the limitations recited in independent claims 1 and 21 (and claims 2-6, 15-19, 22-24 and 33-34 which respectively depend therefrom). Accordingly, this rejection should be withdrawn.

B. Rejection of Claims 7, 8, 14, 20, 25, 26, and 32 Under 35 U.S.C. §103(a)

Claims 7, 8, 14, 20, 25, 26, and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Allen, et al. as applied to claims 1 and 21 above and further in view of Hower, Jr. et al. (U.S. Patent No. 5,467,434). It is respectfully requested that this rejection be withdrawn for at least the following reason. Allen, et al. and Hower, Jr. et al. individually and in combination, do not teach or suggest all limitations of the subject claims.

To reject claims in an application under 35 U.S.C. §103, an examiner must establish a prima facie case of obviousness. A prima facie case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j).

Independent claim 20 recites a system for integrating and controlling assembler/finishing processes. A production monitor controller separates a production job into job segments ***based upon the capabilities and constraints of devices to be used in the production process.*** At least one database stores information concerning the capabilities and constraints of devices to be used in the production process and for storing

job segment descriptions. A finishing module coordinator, in communication with assembler/finisher devices and with at least one database, tracks job segments during the production process. Allen in combination with Hower does not teach or suggest such claimed elements of the subject application.

More particularly, Allen in view of Hower does not teach or suggest a production monitor that ***separates a production job into job segments based upon the capabilities and constraints of devices to be used in the production process.*** Instead, Allen teaches a computer that generates an instruction sheet for a standalone finishing machine. The computer does not act as a production monitor, as recited in the subject claims. The computer simply generates and encodes an instruction set that is sent to a printer for submission to a stand alone finishing machine. There is no mention of a production monitor that separates a job into job segments.

Moreover, as noted above, Allen merely discloses printing a computer-readable instruction sheet containing computer readable finishing instructions. There ***is no mention of generating such instructions based at least in part upon constraints of a finishing device.*** Hence, Allen does not teach or suggest job coordination information which is based at least in part upon constraints of a finishing device. There is no mention of a document that includes instructions based at least in part upon constraints of the finishing device. For instance, as disclosed by Allen, the instructions simply relate to one or more tasks to be performed by a finishing machine. However, ***there is no mechanism, device or process disclosed by Allen that outputs these instructions based on the constraints of the finishing device.*** Such instruction generation is recited in the subject claims and is deficient in Allen.

Further, Allen in view of Hower does not contemplate separating a production job into segments based upon the capabilities and constraints of devices used in a production process. Rather, ***there is no mention of the capabilities or constraints of such devices.*** The system disclosed in Allen does not refer to any device constraints and thus, such constraints are not employed to separate a production job into segments.

In view of at least the foregoing, it is respectfully submitted that Allen and Hower individually and in combination do not make obvious applicants' invention as recited in independent claim 20, and dependent claims 7, 8, 14, 25, 26, and 32. Accordingly, this rejection should be withdrawn.

C. Rejection of Claims 9-13 and 27-32 Under 35 U.S.C. §103(a)

Claims 9-13 and 27-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Allen, et al. and Hower, Jr. et al. as applied to claims 8 and 26 above, and further in view of Neilsen (U.S. Patent No. 6,639,687). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 9-13 and 27-32 are dependent on independent claims 1 and 21 respectively and Neilsen does not make up for the aforementioned deficiencies of Allen, et al. and Hower, Jr. et al. as noted above.

CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-34) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Response A. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

Again, in the event the Examiner considers personal contact advantageous to the disposition of this case, should there be issues that can be settled over the phone, he is encouraged to call Pat Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

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Date

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